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In re Patent Application of:

Jerrold V. Hauck, et al.

Application No.: 09/059,533

Filed: April 13, 1998

For: EARLY ACKNOWLEDGMENT OF PRIMARY  
PACKETS

Examiner: Joseph D. Torres

Art Unit: 2133

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**REPLY BRIEF**

Appellants submit, in triplicate, the following Reply Brief pursuant to 37 C.F.R. § 1.193(b) for consideration by the Board of Appeals and Interferences. The Reply Brief is responsive to the Examiner's Answer.

**ARGUMENT**

**I. Grouping of Claims**

The Examiner suggests, on page 3 of the Examiner's Answer, that all of Appellants' pending claims (Claims 1-11) stand or fall together because Appellants' brief did not include reasons for the statement that the claims stand or fall together. However, the Examiner acknowledges that the claims were grouped separately and addresses the distinct arguments for each group separately in the Response to Argument section of the Examiner's Answer (beginning on page 14).

Appellants first note that the claims are separated into distinct groups and that the reasons for the independent patentability of each group are separately set forth in the Argument section of

the brief. Appellants also affirmatively state in the brief that the independent patentability of each group of claims will be discussed in the Argument section (Appellants' brief, page 4, lines 11 and 12). Second, Appellants submit that, if the Examiner concluded that Appellants' brief did not comply with 37 C.F.R. § 1.192(c)(7), Appellants should have been given adequate notice of the noncompliance (37 C.F.R. § 1.192(d)) and an opportunity to correct the brief (MPEP § 1206).

In light of Appellants' affirmative statement that the claims do not stand or fall together, the reasons set forth for the independent patentability of each group in the Argument section of the brief, and the lack of any notice of noncompliance or an opportunity to correct the brief, Appellants respectfully request that the Board consider each group of claims independently such that Appellants' claims do not stand or fall together on this appeal.

## **II. Claims 4-11 Rejected Under 35 U.S.C. § 112**

In responding to Appellants' arguments regarding the 35 U.S.C. 112, first paragraph rejection, the Examiner relies on Teleflex, Inc. v. Ficosa North America Corp., 63 U.S.P.Q.2d 1374 (Fed. Cir. 2002), for the proposition that claims are given their ordinary meaning unless the patentee demonstrates intent to deviate from the ordinary meaning or by characterizing the invention in the intrinsic record **using words or expressions of manifest exclusion or restriction** (as emphasized by Examiner). In response, Appellants submit that the Examiner's reliance on the Teleflex case is misplaced and that the case is factually irrelevant to the patent examination process.

First, the analysis and holding of the Teleflex case are inapplicable here since they are directed towards claim interpretation of an issued patent, which is not the same as claim interpretation to be used during examination (MPEP § 2111.01). For example, the portion of the Teleflex holding that was emphasized by the Examiner is directed towards analysis of the intrinsic record (e.g., prosecution history, prior art, etc.), which is appropriate during litigation over an issued patent but not during examination. Second, the accused infringer in Teleflex was attempting to narrowly construe the claim language of an issued patent by focusing on the use of certain terminology as applied to a preferred embodiment.

In the present appeal, Appellants are not attempting to interpret the meaning of claim terminology of an issued patent or to reference one preferred embodiment to overcome the plain meaning of a claim limitation in an issued patent. Thus, Teleflex should have no bearing on the Board's decision.

Rather, Appellants merely seek to obtain an interpretation that is consistent with that set forth in MPEP § 2111, which indicates that during patent examination, the claims must be "given the broadest reasonable interpretation consistent with the specification" and that the broadest reasonable interpretation must also be consistent with the interpretation that those skilled in the art would reach. Appellants' interpretation of the disputed terminology (e.g., the term "concurrently") is discussed below in detail.

The Examiner also hints at the notion that Appellants' claims are not supported and/or enabled by the disclosure by citing MPEP § 2173.04. However, as noted in Appellants' Second Supplemental Appeal Brief, under MPEP § 2163.06, the claims as filed in the original specification are part of the disclosure. Thus, Appellants' original disclosure, including original independent Claims 4, 5, and 9, teaches "concurrently" sending (Claim 4) and generating (Claims 5 and 9) a NAK. For at least this reason, Appellants believe that the specification, as filed, is enabling and definite.

The Examiner gives a definition of the term "concurrently" from Webster's Dictionary and claims that it is the only relevant definition provided by the dictionary. Specifically, the definition given is: (1) operating or occurring at the same time; or (2) running parallel and convergent (specifically, meeting or intersecting at a point). Given this definition, the Examiner concludes that Appellants' specification does not teach concurrently sending a NAK with the receiving of a primary packet.

Although Appellants disagree with the idea that the definition provided by the Examiner can be the only appropriate definition, Appellants submit that even under the Examiner's definition, the plain meaning of the term "concurrently" is both enabled and definite as used in Appellants' claims. Specifically, the Examiner's definition indicates that the term "concurrent" can be used to mean that

two or more events or operations can run or occur at the same time (e.g., in parallel) and be convergent (e.g., meet at a point). Appellants note that the definition provided by the Examiner does not indicate that to be convergent requires meeting at all points, most points, or several points. Rather, convergent is used in the definition to indicate meeting at a single point. Thus, the notion presented by the Examiner in the Office Action dated December 13, 2002, that “concurrently” necessarily implies that two operations require the same amount of time (e.g., meeting at all points) is not harmonious with the Examiner’s own definition from Webster’s Dictionary.

Therefore, given the broadest reasonable interpretation of the plain meaning of the term “concurrently” as defined by the Examiner, Appellants submit that the term “concurrently” is both enabled and definite as used within Appellants’ claims to indicate that the occurrence of the two events need only overlap for at least some period of time.

The Examiner also suggests that the term “during” could be used to replace “concurrently.” However, Appellants submit that the term “during” is no clearer than “concurrently” and that Appellants should not be required to amend a term that is both enabled and definite.

In light of the foregoing, Appellants submit that claims of Groups II-IV are enabled and definite. Thus, the 35 U.S.C. 112 rejections should be overturned.

### **III. Claims 1-11 Rejected Under 35 U.S.C. § 103(a)**

#### **Group I**

The Examiner reiterates the opinion that Boal teaches receiving a NAK while a packet is being transmitted. However, Appellants note that every claim limitation must be given weight. Here, Claim 1 recites, among other limitations, receiving a NAK while the primary packet is being transmitted (emphasis added).

As discussed in Appellants’ Second Supplemental Appeal Brief, Boal discloses a series of transmissions with waiting states disposed between transmissions to receive replies that indicate whether transmission should be resumed, aborted, or delayed. Thus, receipt of a reply during a waiting state of Boal cannot render obvious receipt of a NAK while a primary packet is being

transmitted, as recited in Appellants' Claim 1. Moreover, if the reply of Boal indicates that transmission should not be resumed (e.g., a NAK), no further transmission is sent, which renders the receipt of the reply (e.g., NAK) a post-transmission receipt that cannot read upon receipt while a packet is being transmitted, as recited in Claim 1.

The Examiner further notes that the transmitter of Boal, upon receipt of the reply, makes a determination of whether to **immediately** send, abort, or wait to send a packet data frame (as emphasized by Examiner). In response, Appellants note that the determination step of Boal, no matter how quickly it is made, is still made during the waiting state and does not change the fact that the reply is also received during the waiting state. Thus, Boal does not disclose receipt of a NAK while the packet is being transmitted.

On page 18 of the Examiner's Answer, the Examiner appears to substitute the term "means for replying" in place of the term "full duplex bus," as recited in Appellants' Claim 1 and concludes that Boal discloses a means for replying that reads upon Appellants' full duplex bus. However, such a substitution is impermissible since the terms "means for replying" and "full duplex bus" are not equivalent for the purpose of claim interpretation during examination. Rather, the Examiner is applying an interpretation to Appellants' Claim 1 that is unreasonably broad.

The Examiner further asserts that Boal would motivate one of skill in the art to use any bus, including a full duplex bus. Although Appellants disagree with this conclusion since Boal neither teaches nor suggests a full duplex bus, the system and method of Boal would still take turns transmitting packet information and receiving replies on any other bus structure. The conclusion that the manner in which Boal would transmit and receive information would change based simply on transference to a different bus protocol could only be arrived at through impermissible hindsight since Boal does not teach or suggest adaptability of the method based on other bus protocols, specifically a full duplex bus.

The Examiner additionally contends that Boal advocates the elimination of time wastage, which provides motivation to use Boal in conjunction with a full duplex bus. Appellants disagree since Boal does not teach or suggest a full duplex bus, and even if a full duplex bus were used, the

deficiencies of Boal would still be present. Moreover, the portion of Boal cited to support the Examiner's position (page 13, lines 26-29) does not merely advocate elimination of time wastage. Rather, the cited portion of Boal discloses that a processed reply may be at least partially evaluated during receipt of the data frame and sent immediately thereafter (e.g., after the entire packet has already been sent). Thus, the cited portion of Boal cannot achieve the same time savings as that possible by following the method of Claim 1 since the cited portion of Boal does not contemplate aborting transmission without sending all of the packet since the entire packet has already been sent.

The Examiner asserts that Appellants' purpose of Claim 1 is to eliminate time wastage so that bandwidth can be reclaimed and concludes that Appellants admit that the motivation of Boal is both valid and the same as Appellants' motivation (e.g., to combine Boal with a full duplex bus). In response, Appellants agree that elimination of time wastage can be one advantage achieved by Claim 1. However, Appellants have made no admissions and make none herein regarding the validity of the motivation of Boal or whether Appellants' motivation is the same as that of Boal.

In light of the foregoing, Appellants submit that claims of Group I are not obvious over Boal. Thus, the 35 U.S.C. 103(a) rejection should be overturned.

#### Group II

The Examiner contends that Boal discloses an overlap between the sending of a NAK and the receiving of a primary packet. In response, Appellants note that Figures 2-4 and the accompanying text of Boal clearly show that at no time does the receipt of a packet or any portion thereof overlap (e.g., occur concurrently) with sending a reply. Rather, the figures and text of Boal show that transmission is halted until a reply is received, and transmission is then resumed, if necessary.

Accordingly, the 35 U.S.C. 103(a) rejection of the claim of Group II should be overturned.

#### Group III

The Examiner implies that Appellants base their argument on the fact that Claim 5 recites generation of the NAK if the primary packet cannot be successfully accepted and relies on Boal (page 3, second paragraph) to show this functionality. However, Appellants reiterate that there does not appear to be any explicit or implicit indication that Boal contemplates transmission of a primary packet on a full duplex bus, as recited in Appellants' independent Claim 5. The lack of any teaching or suggestion of a full duplex bus in Boal is fatal to the Examiner's rejection.

Moreover, Boal does not teach or suggest generation of the NAK if the primary packet cannot be successfully accepted, wherein the generation occurs concurrently with the receipt of the primary packet. As discussed in Appellants' Second Supplemental Appeal Brief, Boal discloses different types of packets and their respective manners of operation, none of which teach or suggest all of the limitations of Appellants' Claim 5.

The LDPR packet appears to be the most relevant to Appellants' Claim 5 (and is capable of the function cited by the Examiner at page 3, second paragraph of Boal) but still falls short of rendering Claim 5 obvious. Specifically, Boal begins processing the second reply of the LDPR packet after receipt of the header, and the processing may continue during receipt of the data frame (page 5, lines 16-21). However, Appellants' Claim 5 does not merely recite generation of the NAK concurrently with the receipt of the primary packet.

Rather, Claim 5 also recites that the NAK is generated if the primary packet cannot be successfully accepted (emphasis added). At least this limitation is neither taught nor suggested by Boal since, in an LDPR transaction, the receiver accepts the entire packet (e.g., header and data frames) and then sends a processed reply only to ensure that the packet was correctly received (page 5, lines 24 and 25). The receiver makes the determination of whether the packet can be successfully accepted based on the header and, if so, sends a positive first reply, which is not generated concurrently with receipt of a primary packet (page 5, lines 7-15).

If the first reply indicates that the packet cannot be successfully accepted, the transmission is aborted or delayed. If the transmission is aborted, no data frame is sent, and no processed reply can be generated during receipt of the data frame. If, however, the packet can be accepted (or can

now be sent after a delay), the processed reply that is created during arrival of the data frame cannot be properly considered to be generated in response to whether the packet can be accepted (since that determination has already been made). Rather, as mentioned earlier, the processed reply is merely created to ensure that the packet was properly received.

If no first reply is sent (e.g., simplified LDPR), no determination is ever made of whether the packet can be successfully accepted. Thus, for a simplified LDPR transaction, the processed reply cannot be presumed to be generated "if the primary packet cannot be accepted," since the entire packet will be automatically accepted and then merely checked for integrity.

In light of the foregoing, Appellants submit that claims of Group III are not obvious over Boal. Thus, the 35 U.S.C. 103(a) rejection should be overturned.



**CONCLUSION**

For the reasons specified above, the rejection of all claims should be overturned and the claims allowed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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